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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,905	09/29/1999	KENNETH WALSH	S1237/7011/E	4597

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EXAMINER

NICKOL, GARY B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,905

Applicant(s)

WALSH, KENNETH

Examiner

Gary B. Nickol Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Request for Continued Examination

The request filed on 11-26-01 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/408905 is acceptable and a RCE has been established. Claims 1-5 are pending and are currently under prosecution. An action on the RCE follows.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Rejections Maintained

Claims 1-4 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Cuevas et al. (Eur.J.Med.Res, Vol. 2, pages 465-468, November, 1997) in view of Datta et al. (Cell, Vol. 91, pages 231-241, October, 1997) for the reasons of record. (see Paper No. 13, pages 4-5 and Paper No. 16).

Applicant's Declaration and after-final response (Paper No. 20) are not found persuasive for the following reasons:

1. Applicants argue that exhibit A establishes a date of conception of the invention prior to October 17, 1997, which is the publication date appearing on the S. Datta *et al.* reference (Declaration, page 3, No. 9). On the contrary, exhibit A establishes a date in November of 1997 which is after the publication date of the prior art Datta *et al.* (Declaration, page 2, No. 5).

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2. Applicants argue that Exhibit B establish due diligence in reducing the invention to practice from a date prior to the publication date of the Datta *et al.* reference. Applicants further argue that the experiments in Exhibit B establish that Akt inhibits apoptotic cell death of endothelial cells and cardiomyocytes, respectively. This argument has been considered but is not found persuasive. Pages 5, and 7-8 of Exhibit B were performed in 1998, which is after the publication date of the prior art Datta *et al.* Lastly, although completed in 1996, the experiments on page 6 of Exhibit B do not describe the results of experiments which establish that Akt inhibits apoptotic cell-death. These results appear to measure VEGF stimulation in endothelial cells (see Y axis on page 6).
3. The Declaration is unsigned.

Claim 5 remains objected to for the reasons of record in Paper No. 13, page 5.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.
Examiner
Art Unit 1642

GBN
January 9, 2002


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
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